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| 10/551,577 | 10/03/2005 | Hisato Uto | Q90071 | 3885 |

23373 7590 07/27/2007
SUGHRUE MION, PLLC
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WASHINGTON, DC 20037

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| EXAMINER |
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SINGH, ARTI R

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| ART UNIT | PAPER NUMBER |
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1771

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| MAIL DATE | DELIVERY MODE |
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07/27/2007

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

| | | | |
|------------------------------|-------------------------------|----------------------------|--|
| Office Action Summary | Application No. 10/551,577 | Applicant(s) UTO ET AL. | |
| | Examiner Ms. Arti Singh | Art Unit 1771 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☐ Claim(s) ____ is/are pending in the application.
4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1,2,4,5,7 and 8 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. ____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|--|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s)/Mail Date. ____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date <u>04/16/07</u> . | 6) <input type="checkbox"/> Other: ____ |

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DETAILED ACTION

Response to Amendment

1. The Examiner has carefully considered Applicant's amendments and accompanying remarks dated 04/16/07. Applicant's amendments to the specification to remedy the trademarks has been entered and the objection made to same now withdrawn. The IDS with attached references has also been received and is greatly appreciated. The objection made over the IDS in paragraph 2 of the previous office action is also withdrawn. Applicant's amendments to claim 1 and 4, cancellation of claims 3 and 6 have both been entered. Thus, at this time in the prosecution only claims 1, 2, 4, 5, 7 and 8.

Response to Arguments

2. Applicant's arguments with respect to claims 1, 2, 4, 5, 7 and 8 have been considered but are moot in view of the new ground(s) of rejection. Applicant's traversal is the combination of references does not teach the use of a release base layer on a transfer foil. JP 9109333 issued to DAINIPPON PRINTING CO LTD remedies this.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 1, 2, 4, 5, 7 and 8 are rejected under 35 U.S.C. 103(a) as being unpatentable over USPN 6183842 in view of JP 62-198455 A (as cited in the search report) further in view of JP 9109333.

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5. USPN 6183842 issued to Shimizu et al discloses making a decorative laminate comprising a substrate layer composed of a polyester type resin layer and a transfer foil laminated to it (abstract, column 4, line 31-column 5 line 5). The resin layer is may be embossed to created concavities to which the foil may be transferred upon (column4, line 63). Shimizu et al does not suggest scaring the resin layer.

As cited in the search report, which at this point the Examiner must believe, is true, since the Examiner cannot obtain the cited reference, nor has Applicant provided the same. However, the cited search report states that in Document 4 (JP 62-198455 under the heading "Effects of the Invention" that scraping is a well know technique and utilized by those skilled in the art. Thus, a skilled artisan would have found it obvious to manipulate the surface of Shimizu et al, instead of embossing. One would have been motivated to scrape by hand instead of utilizing a machine embossing treatment motivated by the desire to reduce economical costs in manufacturing said composite.

It should be noted the Merriam Webster's Dictionary defines scrape as

1 a : to remove from a surface by usually repeated strokes of an edged instrument b : to make (a surface) smooth or clean with strokes of an edged instrument or an abrasive

2 a : to grate harshly over or against b : to damage or injure the surface of by contact with a rough surface c : to draw roughly or noisily over a surface. Both of these definitions read on embossing of a surface.

The above combination also fails to suggest the use of a release base layer. This is remedied by JP 9109333, which teaches a surface protection layer laminated to a decorative sheet. A person having ordinary skill in the art at the time the invention was made would have found it obvious to use a surface protection layer in the composite of Shimizu and JP 62-198455. One would have been motivated to do so in order to prevent the migration of

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chemicals from one layer to the other, or alternatively assist in the transportation of rolls of such materials so that the layers don't stick to one another.

Conclusion

6. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ms. Arti Singh whose telephone number is 571-272-1483. The examiner can normally be reached on M-T 9-5:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Terrel Morris can be reached on 571-272-1478. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



Ms. Arti Singh
Primary Examiner
Art Unit 1771

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